

Docket No.: 337348020US1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
Firlik et al.

Patent No.: 7,010,351

Confirmation No.: 8272

Issued: March 7, 2006

Art Unit: 3762

For: METHODS AND APPARATUS FOR  
EFFECTUATING A LASTING CHANGE IN A  
NEURAL-FUNCTION OF A PATIENT

---

Examiner: R. D. Bradford

**REQUEST FOR RECONSIDERATION**

Decisions and Certificate of Correction Branch  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the communication dated January 22, 2008, Applicant respectfully requests that the Request for Certificate of Correction filed on May 25, 2006, for the above-identified patent, be reconsidered in view of the remarks which follow, that each of the Information Disclosure Statements filed on December 5, 2002 and June 5, 2003 were received and acknowledged by the Examiner.

**REMARKS**

Applicants' Request for Certificate of Correction filed on May 25, 2006, was denied by the Decisions and Certificate of Correction branch. Communication dated January 22, 2008, states that the "majority of cited references were not found in the IDS's filed 12/5/02 and 6/5/03". Applicants' attach as Exhibit A, a copy of the Form 1449 received by the Patent Office and reviewed by the Examiner on June 11, 2003.

Attached as Exhibit B, is a copy of the Information Disclosure Statement and Form 1449, received by the US Patent Office on December 9, 2002. Applicants' request that the Corrections Branch review the Exhibits and grant Applicants' Request for Reconsideration.

In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 337348020US1 from which the undersigned is authorized to draw.

Dated: April 28, 2000

Respectfully submitted,

By P. T. Parker  
Paul T. Parker  
Registration No.: 38,264  
PERKINS COIE LLP  
P.O. Box 1247  
Seattle, Washington 98111-1247  
(206) 359-8000  
(206) 359-7198 (Fax)  
Attorney for Applicant

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C., 20231, on:



Dec 2, 2002

By:

Melody J. Almberg

Melody J. Almberg

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Andrew D. Firlik *et al.*

APPLICATION No.: 09/802,808

FILED: March 8, 2001

FOR: **METHODS AND APPARATUS FOR EFFECTUATING A LASTING CHANGE IN A NEURAL-FUNCTION OF A PATIENT**

EXAMINER: Roderick D. Bradford

ART UNIT: 3762

CONF. NO: 8272

RECEIVED

DEC - 9 2002

TECHNOLOGY CENTER R3700

**Information Disclosure Statement Within Three Months of Application Filing or Before First Action – 37 CFR 1.97(b)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

1. Timing of Submission

This information disclosure is being filed within three months of the filing date of this application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever occurs last [37 CFR 1.97(b)]. The references listed on the enclosed Form PTO-1449 (modified) may be material to the examination of this application; the Examiner is requested to make them of record in the application.

2. Cited Information

☒ Copies of the following references are enclosed:

- ☒ All cited references
- ☐ References marked by asterisks
- ☐ The following:

☐ Copies of the following references can be found in parent U.S. Application No.

- ☐ All cited references
- ☐ References marked by asterisks
- ☐ The following:

☐ The following references are not in English. For each such reference, the undersigned has enclosed (i) a translation of the reference; (ii) a copy of a communication from a foreign patent office or International Searching Authority citing the reference, (iii) a copy of a reference which appears to be an English-language counterpart, or (iv) an English-language abstract for the reference prepared by a third party. Applicant has not verified that the translation, English-language counterpart or third-party abstract is an accurate representation of the teachings of the non-English reference, though, and reserves the right to demonstrate otherwise.

- ☐ All cited references
- ☐ References marked by ampersands
- ☐ The following:

3. Effect of Information Disclosure Statement (37 CFR 1.97(h))

This Information Disclosure Statement is not to be construed as a representation that: (i) a search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the cited information is, or is considered to be, material to patentability. In addition, applicant does not admit that any enclosed item of information constitutes prior art to the subject invention and specifically reserves the right to demonstrate that any such reference is not prior art.

4. Fee Payment

No fees are believed due. However, should the Commissioner determine that fees are due in order for this Information Disclosure Statement to be considered, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0665.

5. Patent Term Adjustment (37 CFR 1.704(d))

- ☒ The undersigned states that each item of information submitted herewith was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this statement. 37 C.F.R. § 1.704(d).

Respectfully submitted,  
Perkins Coie LLP

Date: 11/27/02

P-T Parker  
Paul T. Parker  
Registration No. 38,264

**Correspondence Address:**

Customer No. 25096  
Perkins Coie LLP  
P.O. Box 1247  
Seattle, Washington 98111-1247  
(206) 583-8888



# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Form PTO-1449 (Modified)  
(Use several sheets if necessary)

## COMPLETE IF KNOWN

Application Number	09/802,808
Confirmation Number	8272
Filing Date	March 8, 2001
First Named Inventor	Andrew D. Firlik
Group Art Unit	3762
Examiner Name	Roderick D. Bradford
Attorney Docket No.	337348020US1

Sheet 1 of 1

## U.S. PATENT DOCUMENTS

Examiner Initials	Cite No.	U.S. Patent or Application		Name of Patentee or Inventor of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Figures Appear
		NUMBER	Kind Code (if known)			
		6,128,538		Fischell et al.	10/03/00	

RECEIVED

DEC - 9 2002

TECHNOLOGY CENTER R3700

## FOREIGN PATENT DOCUMENTS

Examiner Initial	Cite No.	Foreign Patent or Application		Name of Patent	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Figures Appear	T
		Office	NUMBER				
		PCT	WO		17/08/95		
		PCT	WO		27/12/01		

OTHER

Examiner Initials	Cite No.	Include (book, maga)	PCT Internati PCT/US02/07	DOCUMENTS (when appropriate), title of the item volume issue number(s), publisher, city	T
				uroscience, Inc.	

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application(s).

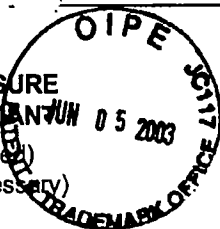
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> Form PTO-1449 (Modified) (Use several sheets if necessary)				<b>COMPLETE IF KNOWN</b>			
				Application Number		09/802,808	
				Confirmation Number		8272	
				Filing Date		March 8, 2001	
				First Named Inventor		Andrew D. Firlík	
				Group Art Unit		3762	
				Examiner Name		Roderick D. Bradford	
Sheet	1	of	1	Attorney Docket No.		337348020US1	

U.S. PATENT DOCUMENTS						
Examiner Initials	Cite No.	U.S. Patent or Application		Name of Patentee or Inventor of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Figures Appear
		NUMBER	Kind Code (if known)			
		6,128,538		Fischell et al.	10/03/00	

FOREIGN PATENT DOCUMENTS								
Examiner Initial	Cite No.	Foreign Patent or Application			Name of Patentee or Applicant of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Figures Appear	T
		Office	NUMBER	Kind Code (if known)				
		PCT	WO 95/21591		University of Iowa Research Foundation	17/08/95		
		PCT	WO 01/97906		Advanced Bionics Corp	27/12/01		

OTHER PRIOR ART-NON PATENT LITERATURE DOCUMENTS		
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume issue number(s), publisher, city and/or country where published.
		PCT International Search Report, Applicant: Vertis Neuroscience, Inc. PCT/US02/07077, October 22, 2002, 7 pgs.

EXAMINER	DATE CONSIDERED
*EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application(s).	



### STATEMENT BY APPLICANT

Form PTO-1449 (Modified)  
(Use several sheets if necessary)

CONFIDENTIAL IF KNOWN

Application Number	09/802,808
Confirmation Number	8272
Filing Date	March 8, 2001
First Named Inventor	Andrew D. Firlik
Group Art Unit	3762
Examiner Name	Roderick D. Bradford
Attorney Docket No.	33734-8020US1

Sheet

1

of

2

## U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.	U.S. Patent or Application		Name of Patentee or Inventor of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		NUMBER	Kind Code (if known)			
L.B.		US2002/0028072		Kashiyama	03/07/02	
		US2002/0169485		Pless et al.	11/14/02	
		US2002/0099412		Fischell et al.	07/25/02	
		5,370,672		Fowler et al.	12/06/94	
		5,938,689		Fischell et al.	08/17/99	
		5,983,140		Smith et al.	11/09/99	
		6,006,124		Fischell et al.	12/21/99	
		6,016,449		Fischell et al.	01/18/00	
		6,052,624		Mann	04/18/00	
		6,061,593		Fischell et al.	05/09/00	
		6,128,538		Fischell et al.	10/03/00	
		6,134,474		Fischell et al.	10/17/00	
		6,161,045		Fischell et al.	12/12/00	
		6,353,754		Fischell et al.	03/05/02	
		6,354,299		Fischell et al.	03/12/02	
		6,360,122		Fischell et al.	03/19/02	
		6,427,086		Fischell et al.	07/30/02	
		6,459,936		Fischell et al.	10/01/02	
		6,466,822		Pless	10/15/02	
		6,473,639		Fischell et al.	10/29/02	
L.B.		6,480,743		Kirkpatrick et al.	11/12/02	

**RECEIVED**

JUN 11 2003

TECHNOLOGY CENTER R3700

**EXAMINER**

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application(s).





**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

Form PTO-1449 (Modified)  
(Use several sheets if necessary)

O I P E

JUN 05 2003

TRADEMARK OFFICE

CL. 1. **TE IF KNOWN**

Application Number	09/802,808
Confirmation Number	8272
Filing Date	March 8, 2001
First Named Inventor	Andrew D. Firlik
Group Art Unit	3762
Examiner Name	Roderick D. Bradford
Attorney Docket No.	33734-8020US1

Sheet 2 of 2

**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No.	Foreign Patent or Application			Name of Patentee or Applicant of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T
		Office	NUMBER	Kind Code (if known)				
R.B.		WO	87/07511		Zion Educational Foundation	12/17/87		
		WO	02/09811		Neuropace, Inc.	02/07/02		
		WO	02/36003		Neuropace, Inc.	05/10/02		
		WO	02/38031		Neuropace, Inc.	05/16/02		
		WO	02/38217		Neuropace, Inc.	05/16/02		
R.B.		EP	1145736		Neuropace, Inc.	10/17/01		

**OTHER PRIOR ART-NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume issue number(s), publisher, city and/or country where published.	T
L.B.		International Search Report for Application No. PCT/US02/32695; Applicant: Vertis Neuroscience, Inc.; December 27, 2002; 9 pgs; European Patent Office	

**RECEIVED**  
**JUN 11 2003**  
**TECHNOLOGY CENTER R3700**

EXAMINER

*R. Bradford*

DATE CONSIDERED

12/18/03

\*EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application(s).